



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Ulrich SPECK et al. : Group Art Unit: 1616
Serial No.: 09/446,328 : Examiner: HARTLEY, Michael G.
Filed: April 17, 2000 :
For: USE OF INTRAVENOUS CONTRAST MEDIA FOR PROJECTION
MAMMOGRAPHY

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REPLY

Assistant Commissioner for Patents
Washington, D.C. 20231

SIR:

In response to the Office Action dated August 8, 2002, please consider the following remarks.

REMARKS

Rejection of Claims 38-41 Under 35 U.S.C. § 112, first paragraph

The Office Action alleges that the claims lack written description. Applicants respectfully disagree.

The Office Action alleges that the specification fails to show a representative number of contrast agents with the claimed identifying characteristics to show possession of the broad class claimed. However, Applicants have sufficiently demonstrated possession of the class claimed. One of ordinary skill in the art, upon reading the specification and the examples of contrast agents, would have recognized possession of the claimed classes, including those described by negative limitations. It is not required of applicants to explicitly recite features of an invention that are readily understood by those skilled in the art to not being part of the invention. *In re Alton*, 76 F.3d 1168, 37 USPQ.2d 1578 (Fed. Cir. 1996).

The Office Action alleges that the recitation of, e.g., "non-peptide," to describe a contrast agent would include any compound that is not made up of repeating units of amino